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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | Docket Number (Optional) 50269-0585 |
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| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _6/23/06_ Signature _Annette Valdivia_ Typed or printed name _Annette Valdivia_ | Application Number 10/057,735 | Filed 1/22/2002 |
| | First Named Inventor | |
| | Art Unit 2144 | Examiner Maniwang, Joseph R. |

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record. Registration number _58,764_

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

_____
Signature

Joseph M. Olsen
Typed or printed name

408.414.1080
Telephone number

06/23/2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

## REMARKS

As will be seen from the discussion below, the Examiner's rejections of the pending claims under 35 U.S.C. § 103(a) do not establish a *prima facie* case of obviousness. There are clear errors of fact and of law in the Examiner's rejections that make the rejection improper and without basis.

### Issue 1 – Claims 1-3, 5, 7, 9-19, 22-25, and 29-37

The Office Action of March 23, 2006 rejects Claims 1-3, 5, 7, 9-19, 22-25, and 29-37 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Published App. 2001/0027474 to Nachman et al. ("Nachman") in view of U.S. Published App. 2001/0018658 issued to Kim ("Kim"). This rejection is improper as a matter of fact and of law.

First, Claim 1 recites, among other features, "**receiving an initial indication that the guest user desires to communicate with a selected registered user by instant messaging.**" Claim 1 recites a method that allows guest users to an online instant messaging service to *initiate communication* with a *selected* registered user with whom the guest user would like to communicate without having to download and install client side instant messaging software or registering with the instant messaging service.

Such a method is neither taught nor suggested by Nachman or Kim. Instead, Nachman discloses a method for exchanging messages between registered viewers of a WWW page (See Nachman, Abstract) and Kim describes a method for allowing *registered users* to initiate contact with guest users as they navigate a virtual world. (See Kim, Abstract and ¶ 43). There is no mention in Nachman or Kim of allowing a guest user to initiate communication with a selected registered user.

The Examiner correctly notes that Nachman does not teach or suggest "not requiring the guest user to register as a user of the instant messaging system." (See Office Action, Page 2). Although, the Examiner does allege that Kim discloses this element of Claim 1. (See Office Action, Page 2). Specifically, the Examiner cites paragraphs 41 and 61 of Kim in support of this alleged teaching. The Applicants have carefully reviewed Kim and have found nothing in Kim that teaches or suggests "receiving an initial indication that the guest user desires to communicate with a selected registered user by

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instant messaging." Therefore, the Applicants respectfully submit that such a rejection constitutes clear error in fact.

To expound, Kim describes a virtual world in which "helpees" and "helpers" participate. A helpee in the Kim system "selects a help-request button of a toolbar in a chatting client and enters a message requesting help in an input window. The request is transmitted to a chatting server. The server sends a signal *to all the users in the same site*, informing that a helpee requested help. . . . The helper selects a help-helpee item to display a new window on the screen, and enters messages for giving help." (See Kim, ¶ 62). In other words, Kim helpees send a broadcast message to *all* available helpers on the system. This requires no knowledge of what users (registered or otherwise) are on the Kim system. Moreover, it does not allow users to pinpoint or specify a selected user with whom they would like to communicate. This clearly differs from "receiving an initial indication that the guest user desires to communicate with a selected registered user by instant messaging" as recited in Claim 1. Therefore, the Examiner erred as a matter of fact in citing Kim to reject the Claim 1. Moreover, because Kim does not teach at least that element of Claim 1, the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, as a matter of law, the rejection of Claim 1 should be withdrawn.

In addition, the Examiner's assertion that "it would have been obvious to one of skill in the art to combine the Nachman's invention with Kim's guest user system in order to enhance user's convenience and usability of virtual worlds by means for representing a user by a representative in the virtual world" is also clearly erroneous as a matter of fact and of law. (See Office Action, Page 2-3). The Applicants respectfully note that combining Nachman and Kim do not enhance user convenience and usability given the systems described. Moreover, both references teach away from such a combination.

For example, the Nachman system requires a user to register in order to be useful. Nachman describes a system "for monitoring Internet users browsing habits and web page preferences." (See Nachman, ¶ 16). To do so, a user is required to register so that "user details are stored on the Web Messaging central Server. In one embodiment of the present invention, user information may also be stored on the client browser program by

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means of HTTP or WAY cookies. Upon registration, the UID code assigned to the user is stored on the web browser's cookie file and on each access to a WMS, the UID code serves to identify the user according to the registered details included in the WMCS database." (See Nachman, ¶ 40). Registration is a necessary element that allows the Nachman system to monitor a user's Internet usage. Contrary to the Examiner's assertion, allowing guest users on the system would not enhance Nachman. In fact, it would make tracking Internet usage more difficult since the identity of a user would not be clear.

Similarly, Kim is not enhanced by Nachman. Kim describes a system where points are granted to helpers as they help helpees. Allowing guest users to initiate contact with helpers would run contrary to its helper/helpee point system. In Kim, helpers initiate contact with helpees in order to gain points. (See Kim, ¶ 25). Thus, the Examiner's claim that the combination would be obvious "to enhance user's convenience and usability", is clearly wrong as a matter of fact. Neither reference is enhanced by the Examiner's alleged teaching.

In fact, both Nachman and Kim teach away from such a combination. Therefore, as a matter of law, the combination of Nachman and Kim is unworkable. Therefore, the rejection of Claim 1 should be withdrawn

Dependent Claims 2-3, 5, 7, 9-19, and 22-25

Dependent Claims 2-3, 5, 7, 9-19, and 22-25 depend from Claim 1 and, hence, incorporate all of the limitations of Claim 1. The Applicants submit that the rejection of Claims 2-3, 5, 7, 9-19, and 22-25 be withdrawn for at least the same reasons as those given above.

Claims 29-37

Independent Claim 29, 34, and 37 are respectively a method claim, a system claim, and a computer readable storage medium claim which contain limitations reasonably analogous to Claim 1. The Applicants submit that these claims along with their Dependent Claims 30-33 and 35-36 are patentable for at least the same reasons given above.

## Issue 2 – The Other Dependent Claims

Claims 6, 20, 21, and 26-28 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nachman in view of Kim, further in view of U.S. Published App. 2002/00169875 to Furui ("Furui"). In addition, Claims 4 and 8 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nachman in view of Kim, further in view of U.S. Published App. 2002/0099777 to Gupta ("Gupta"). These rejections are also improper.

Claims 4, 6, 8, 20, 21, and 26-28 depend from Claim 1 and incorporate all of the limitations of Claim 1. Thus, if Claim 1 is patentable over Nachman and Kim, then it follows that Claims 6, 20, 21, and 26-28 are also patentable over Nachman and Kim.

As argued above, Nachman and Kim fail to teach or suggest at least one element of Claim 1. Both Furui and Gupta also fail to teach or suggest this element (and the Examiner has not asserted that they do). Thus, even if the references were combined (assuming arguendo that it would have been obvious to combine the references), the combination still would not produce the method of Claim 1. Thus, the Applicants submit that Claim 1 is patentable over an alleged Nachman, Kim, and Furui combination or a Nachman, Kim, and Gupta combination. The Applicants further submit that Claims 4, 6, 8, 20, 21, and 26-28, which depend from Claim 1 and which recite further advantageous aspects of the invention, are likewise patentable over the alleged combinations for at least the reasons given above in connection with Claim 1.

## CONCLUSION

For at least the reasons above, the Applicants respectfully request that the rejections of all the pending claims be reversed.